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10/660,030	09/11/2003	Kathryn E. Foster	H 50017 HST	5806

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EXAMINER	
DELCOTTO, GREGORY R	

ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/660,030	FOSTER, KATHRYN E.	
	Examiner	Art Unit	
	Gregory R. Del Cotto	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 October 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-8,10-14 and 17-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2,3,5,7,8,10-14 and 17-25* is/are rejected.

7)☒ Claim(s) *4,6 and 7* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 2-8, 10-14, and 17-25 are pending. Claims 1, 9, 15, and 16 have been canceled. Applicant's arguments and amendments filed 10/19/05 have been entered.

Applicant's election of Group I, claims 1-14 in the reply filed on 10/19/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 15 and 16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/19/05. Note that, claims 15 and 16 have been canceled.

Objections/Rejections Withdrawn

The following objections/rejections as set forth in the Office action mailed 4/19/05 have been withdrawn:

The rejection of claims 1-8 under 35 U.S.C. 102(a) as being anticipated by WO02/053802 has been withdrawn.

The rejection of claims 1-8 under 35 U.S.C. 102(e) as being anticipated by Wilson (US 2002/0144718) or Wilson (US 2004/0002437) has been withdrawn.

The rejection of claims 1-3, and 5 under 35 U.S.C. 102(b) as being anticipated by Figdore et al (US 6,001,793) has been withdrawn.

The rejection of claims 1-3, 5, and 8-10 under 35 U.S.C. 103(a) as being unpatentable over Seaman, Jr. (US 4,978,469) has been withdrawn.

The rejection of claims 1-10 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27, 29-32, and 36-39 of copending Application No. 10/871,258, claims 1-15 and 63-93 of 10/183662, and claims 21, 23-31, and 34-36 of 10/027445 has been withdrawn.

Claim Objections

Claims 8, 10, 13, and 14 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

With respect to claim 13, this claim fails to further limit claim 12 in that claim 13 recites a working coating removal composition containing a concentrate and water wherein claim 12 recites the proportions of the components contained within the two compartment package. For purposes of examination and applying prior art, the Examiner has interpreted claims 10, 13, and 14 to simply require an aqueous composition containing components in the same proportions as claim 17; in other words, it appears that claim 13, which recites a diluted concentrate and does not require a container having two packages, represents the composition of claim 17.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14 and 17-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 14, 17, and 22, these claims are vague and indefinite in that it is unclear if the "ratio" as recited by claims 14, 17, and 22 is a weight, volume, molar, etc. ratio. For purposes of examination, consistent with the specification on page 9, the Examiner has interpreted the ratio as a weight ratio. Clarification is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 8, 10, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seaman, Jr. (US 4,978,469). (Note, claim interpretation as indicated in claim objections section.)

Seaman, Jr. teaches a cleaning compositions containing about 20 to 70% water, 0.5 to 20% nonionic surfactant, 0.5 to 15% alkaline compound, 10 to 60% of ethylene glycol, etc., 0.5 to 20% of ethanol, etc., 0 to 10% of a hardness compound, 0 to 1% of a silicone based defoamer, and 0 to 1% dye. See column 1, lines 37-45 and claim 1.

Suitable alkaline compounds include sodium and potassium hydroxide, monoethanolamine, etc. See column 3, lines 55-62. Suitable nonionic surfactants include a nonylphenol ethoxylate having an average of 9.5 ethoxy units. See column 4, lines 35-50.

Seaman, Jr. does not teach, with sufficient specificity, a composition containing water, an alkoxylated aromatic alcohol, an inorganic base, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition containing water, an alkoxylated aromatic alcohol, an inorganic base, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Seaman, Jr. suggest a composition containing water, an alkoxylated aromatic alcohol, an inorganic base, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Claims 2, 3, 5, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO01/00765.

'765 teaches an aqueous liquid detergent composition comprising an effervescent agent-containing component and a source of peroxide component wherein the effervescent agent-containing component is contained within a first compartment of

a dual compartment container and the source of peroxide component is contained within the other compartment of the dual compartment container such that the effervescent agent containing component and the source of peroxide component only effervesce after being mixed together. See page 2, lines 20-30. Specifically, '765 teaches a heavy duty aqueous liquid detergent composition containing a dual compartment container wherein the first compartment contains 1.1% monoethanolamine, nonionic surfactant, water, ethanol, etc., and the second compartment contains 3.46% sodium hydroxide, 20.90% citric acid, water, etc. See pages 75, line 1 to page 76, line 10. Other suitable nonionic surfactants include C6-C12 alkyl phenol ethoxylates, etc. See page 10, lines 15-20.

'765 does not teach, with sufficient specificity, a two compartment package containing a coating removal composition in which the first part contains an alkoxylated aromatic alcohol and amine and the second part comprises an inorganic base as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a two compartment package containing a coating removal composition in which the first part contains an alkoxylated aromatic alcohol and amine and the second part comprises an inorganic base as recited by the instant claims, with a reasonable expectation of success, because the broad teachings of '765 suggests a two compartment package containing a coating removal composition in which the first part contains an alkoxylated aromatic alcohol and amine and the second part comprises an inorganic base as recited by the instant claims.

Claims 8, 10, 13, 14, 17, 19-22, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota et al (US 5,679,629).

Kubota et al teach a detergent for hard surfaces containing a mixture consisting of at least two compounds which are ethoxylated unsubstituted phenols. The detergent composition has excellent detergency and foaming properties and is useful for removal of denatured oily dirt in the kitchen. See Abstract. Additionally, the composition may contain an alkali agent wherein the alkali agent may be any suitable agent including ammonia and alkanolamine. Suitable alkanolamines include monoethanolamine and diethanolamine. See column 3, lines 10-25. The ethoxylated unsubstituted phenols are used in amounts from 0.1 to 30 parts by weight and the alkali agent is used at a proportion of from 0.01 to 20 parts by weight. Water may also be used in the compositions in amounts from 30 to 99.5 parts by weight. The Examiner asserts that ammonia as taught by Kubota et al would fall within "inorganic base" as recited by the instant claims. With respect to the ratio of alkoxylated aromatic alcohol to inorganic base as recited by the instant claims, the Examiner asserts that the teachings of Kubota et al would suggest compositions having the same ratio of alkoxylated aromatic alcohol to inorganic base as recited by the instant claims because Kubota et al suggest compositions containing the same components in the same proportions as recited by the instant claims.

Kubota et al do not teach with sufficient specificity, a composition containing water, an alkoxylated aromatic alcohol, an amine, an inorganic base, and the other

requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition containing water, an alkoxylated aromatic alcohol, an inorganic base, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Kubota et al suggest a composition containing water, an alkoxylated aromatic alcohol, an inorganic base, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Claims 18 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota et al (US 5,679,629) as applied to claims 17, 19-22, 24, and 25 above, and further in view of Seaman, Jr. (US 4,978,469).

Kubota et al are relied upon as set forth above. However, Kubota et al do not teach the use of an inorganic builder such as sodium hydroxide in addition to the other requisite components of the composition as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use an alkaline material such as sodium hydroxide in the cleaning composition taught by Kubota et al, with a reasonable expectation of success, because Seaman, Jr. teaches the equivalence of sodium hydroxide to

monoethanolamine in a similar cleaning composition and, further, Kubota et al teach the use of monoethanolamine.

Allowable Subject Matter

Claims 4, 6, and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the references of record, alone or in combination, teach or suggest a coating removal composition formed from two separate packages in which one package contains the same alkoxylated aromatic alcohol as recited by the instant claims.

Response to Arguments

With respect to the prior art previously applied, Applicant states that there is no suggestion in the references of the ratio of the alkoxylated aromatic alcohol component to base component. In response, note that, the Examiner asserts that the references suggest formulating compositions containing a ratio of the alkoxylated aromatic alcohol component to base component as recited by the instant claims because the references teach that the amounts of alkoxylated aromatic alcohol and base component may be varied which would allow one of ordinary skill in the art to arrive at a composition containing these components in the claimed ratio.

Conclusion

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.

Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory R. Del Cotto
Primary Examiner
Art Unit 1751

GRD
January 9, 2006